

REMARKS

Applicant requests reconsideration and allowance in view of the current amendments and the following remarks. Claims 1-3, 6-9, 12-15, and 18-92 are pending in this application.

This Reply being filed in response to the Final Office Action that was mailed June 19, 2002, which has an appeal that is currently pending. The Final Office Action raised several new issues that may preclude adequate consideration of the appeal on the merits. This Reply attempts to resolve those issues, or at least frame them in furtherance of the appeal.

As will be described, the claim amendments presented by this Reply are formal, primarily addressing issues raised in the Final Office Action. Consequently, they are believed to raise no new issues.

Objections to Claims

Various objections were made to claims in paragraphs 4-10 of the Office Action, which have each been addressed through amendments presented. Specifically, the objections appearing in paragraphs 4-10 have been addressed with minor/formal amendments in the claims 29, 32, 35, 40, 50, 54, 58, 67, and 92.

Note that the objection in paragraph 8 resulted in an amendment to claim 67. In paragraph 8, an objection was made to claim 71 for failing to clearly indicate whether the selecting code segment is the same as the second selecting code segment. In response and to clarify, claim 67 was amended and now recites, "a first selecting code segment."

Furthermore, note that the objection in paragraph 10 referred to claim 50 when citing the following language, "in said one content element an individual recipient." This objection appears to be directed to claim 54, which has been amended appropriately.

Additional claim amendments were made to claims 13, 27, 54, 61, and 62 to address formalities not raised in the objections of paragraphs 9-10. Again, these amendments merely address formalities; they do not raise new issues, and should be entered.

Claim Rejections under 35 U.S.C. § 112

Claims 1, 24, 27, 29, 36, 43, 44, 54, 61, 62, 72, 77, 79, 84, 86, and 91 were rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for three reasons. See Final Office Action paragraphs 11-14. First, the Final Office Action states the claims are a statement of desired results. Second, the Final Office Action states that a lack of interaction exists between the elements, particularly referencing content, score, pool and predicted interest. Third, the Final Office Action states that it is not clear what the selected threshold process is. Notably, although many of these claims have been pending in their present form since filing, these formal matters are being raised for the first time in this Final Office Action. Nevertheless, each point is addressed below.

Addressing the first and second reasons in reverse order, there is an interaction between the elements and the claims are not a statement of desired results. Specifically, claim 1 recites a method to choose whether to distribute a content element. In that claimed method, three steps are recited. A score is determined based on a predicted interest level by an individual in a content element; the determined score is compared with a threshold; and the comparison is used as a basis for determining whether to distribute the content element to an individual. Clearly, there exists interaction among these elements - the score determined by the first step being used as a basis for comparison in the second step and the comparison made in the second step being used as a basis for the determination in the third step.

As for desired results, this rejection does not appear to be properly grounded in 35 U.S.C. §112, 2nd paragraph. The standard for being indefinite is whether the scope of the claim is ascertainable. The breadth of the claim is not to be equated with indefiniteness. See *In re Miller*, 169 U.S.P.Q. 597, 441 F.2d 689 (C.C.P.A. 1971). See also MPEP 2173.04. Because the scope of the claims is believed to be ascertainable, and because an accusation of desired results alone does not seem to discount the existence of the steps recited by these claims (some of which being discussed above), the reversal of the rejection of the claims is requested.

Claims 24, 27, 29, 36, 43, 44, 54, 61, 62, 72, 77, 79, 84, 86, and 91 are similar in structure to claim 1 for the purposes of the rejection in paragraphs 11 and 14, and the reversal of the rejection is similarly requested.

As to the third reason for this rejection, that the “selected threshold” process is not clear, Applicant again submits that this term meets the burden of 112, second paragraph, by conveying an ascertainable scope. Nevertheless, the term “selected” has been deleted to avoid any confusion. Applicant submits that the scope of the term “threshold” is ascertainable for the purposes of analyzing the claim and serving the notice function. Additionally, for purposes of addressing comments made in the Final Office Action thoroughly, Applicant notes that the term “selected threshold” is not a process for the purposes of claim 1; rather, the selected threshold is an object that is compared with a score responsive to a predicted interest by an individual recipient. Claims 24, 27, 29, 36, 43, 44, 54, 61, 62, 72, 77, 79, 84, 86, and 91 are similar in structure to claim 1. Accordingly, the reversal of the rejection of claims 1, 24, 27, 29, 36, 43, 44, 54, 61, 62, 72, 77, 79, 84, 86, and 91 is requested.

The other rejections raised in paragraphs 12 and 13 have been addressed in amendments to claims 36, 67, and 70. Accordingly, the reversal of the rejection of claims 36, 67, and 70 is requested. Paragraph 14 also rejected claims 43, 44, 61, 62, 77, 84, and 91 for the same reasons described above. Paragraph 14 also rejected claims 43 and 44 indicating that it is not clear where the system “selects responsive to said selected threshold” and what the selected condition is. Although the scope of these claims is ascertainable prior to amendment, these claims have nevertheless been amended to read more consistently with the structure of those claims. Accordingly, the reversal of the rejection of these claims 43, 44, 61, 62, 77, 84, and 91 also is requested, or at the least, further explanation of these grounds of rejection is solicited.

Claim Rejections under 35 U.S.C. 103(a)

Claims 1-3, 6-9, 12-15, 18-23, 24-32, 33, 34, 35, 36-53, and 54-71 are rejected as being obvious over Chaddha ‘293 in view of Reed ‘239. For the reasons set forth below, the reversal of the rejection of Claims 1-3, 6-9, 12-15, 18-23, 24-32, 33, 34, 35, 36-53, and 54-71 is requested.

In claim 1, one of several content elements is given a score based on a recipient’s predicted interest level in the content element, and then, based on a comparison of the score to a threshold, a decision is made concerning whether to distribute the content element(s). Moreover, claim 1 recites deciding whether to distribute a content element based on a comparison between

a threshold and a score that reflects the predicted interest of an individual recipient in the content element. Chaddha fails to disclose at least this aspect of claim 1, as acknowledged by the Office Action which turns to Reed for such disclosure. See Final Office Action page 7. "Chaddha does not expressly disclose the step of determining a score for one of a set of content elements in a pool." Applicant submits that Reed is similarly deficient.

Reed scores a geographic region that is not intended or available for distribution, and consequently, Reed fails to decide whether to distribute that which is being scored - the region. More explicitly, Reed assigns scores to regions as a basis for distributing a load among those regions. Thus, in effect, Reed controls a relative allocation for each of several regions based on scores assigned to those regions, without consideration of whether or what scores are determined for items being allocated for the regions. Thus, Reed controls distribution using a process that scores potential destinations for items to be distributed that is different from the claimed process, which claimed process involves deciding whether to distribute items (e.g., content elements) for which scores are determined.

For the purpose of this rejection, the other rejected independent claims recite elements consistent with those of claim 1. Accordingly, Applicant requests the reversal of the rejection of independent claims 1, 24, 27, 29, 36, and 54. Similarly, Applicant requests the reversal of the rejection of dependent claims 2-3, 6-9, 12-15, 18-23, 25-26, 28, 30-35, 37-53, and 55-71, which depend therefrom.

Claims 72-92 are rejected as obvious over Chaddha '293 in view of Reed '239, and further in view of Logan '827. For at least the reasons set forth below, the reversal of the rejection of claims 72-92 is requested.

The rejected claims recite a personalized scoring system that is used to distribute content to an individual recipient. Specifically, claim 72 recites a method for scoring multiple different content elements for distribution, where the score is responsive to a predicted interest in each of the content elements by an individual recipient.

Neither of Chaddha nor Reed are relied upon for disclosing this limitation. Rather, the Final Office Action turns to Logan. However, in contrast to the claimed limitation mentioned above in which the score relates to the predicted interest of an individual recipient, the cited portion of Logan creates a library of programs that is independent of the intended user.

Specifically, Logan indicates that programs may be organized into genres of movies. Logan's "score" does not vary with the identity of the user. Thus, any such categorization in a library in Logan does not score a content element in a manner responsive to a predicted interest in the content element by an individual recipient, as recited by rejected claim 72.

The difference is significant for various reasons, and in various contexts. For instance, the invention of claim 72 framework can be used to select content that is personalized to a user using a small portion of a larger library. Additionally, the method of claim 72 may be modified in a flexible manner to generate personalized content elements with minimal additional processing required. For example, the score may be recalculated, the selected threshold may be adjusted, and/or the operations may be repeated until a content element is selected.

For the reasons mentioned above with respect to claims 1-3, 6-9, 12-15, 18-23, 24-32, 33, 34, 35, 36-53, and 54-71, neither Chaddha nor Reed describes determining a score for more than one of several different content elements in a pool of content elements. Accordingly, claim 72 and claims 73-78, which depend therefrom, should be allowed. Claims 79-85 are system claims related to the method claims 72-78. Claims 86-91 are program claims related to the method claims 72-78. Accordingly, the reversal of the rejection of claims 72-92 is requested.